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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/732,887	12/09/2003	Teppei Yokota	450100-02742.1	6181

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EXAMINER

HINDI, NABIL Z

ART UNIT	PAPER NUMBER
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2655

DATE MAILED: 08/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/732,887

Applicant(s)

YOKOTA ET AL.

Examiner

NABIL Z. HINDI

Art Unit

2655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-27 is/are allowed.
- 6) ☒ Claim(s) 28-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 6628591.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

In response to applicant's amendment dated March 25, 2005. The following action is taken:

The claims are rejected for the same reasons set forth in the previous office action repeated herein for applicant's convenience.

Claims 28-39 are rejected under improper recapturing and not only claims 28-29 as indicated in the previous office action. Such oversight was due to typographical error.

Claims 28-39 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

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The following limitations are not present in the reissue application and thus broader aspect related to the subject matter that applicant previously surrendered.

“recording means comprising a first security block having an encryption circuit and an authentication processing circuit, said first recording medium comprising a second security block”.

“random-number generation circuit means for generating a session key to be shared with said second security block if said judgment formed from said judging means indicates that said first recording medium is allowed to be dubbed”.

Wherein said first security block sends first authentication data to be said second security block which is generates second authentication data and adds this second authentication data to the first authentication data and sends both authentication data to said recording means to form said judgment”.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 28-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over W097/08695 (corresponding to US Pat# 6,226,247) in view Kuwahara et al (6,449,232). The independent claims merely read on copying a first disk into a second storage medium (another disk) wherein the copying process is controlled based on the disk type (whether the disk is copy protected or not, a single layer disk or not, a CD type medium, a DVD type medium ... etc). The disk type is determined based on a focusing servo signal. The primary reference discloses the use of copying apparatus having a first medium reading head 15, disk type determination means *written on the disk as shown in fig 6B) having a copy permission or inhibiting data and whether the disk is a single or multi layered as cited in column 6 lines 1-9. Therefore copying of the disk into a second disk 2 would be inhibited if the disk were not permissible to be copied. However the primary reference does not disclose the use of a focusing (s-curved signal) to determine the disk type. The secondary reference discloses the use of an s-curved focusing servo signal in order to determine the disk type as shown in figs 27 and 28 for the purpose of time efficiency and increasing the data volume on the disk. It would have been obvious to one skilled in the art at the time the invention was made to use the teaching of the secondary reference and modify the primary reference. Such modification of using a focusing servo to determine the disk type is well established in the art in order to eliminate the need for writing the disk type on the disk and save time in accessing the TOC area to determine the disk type. Thus it would have been obvious to one skilled in the art at the time the invention was made to use the teachings of the

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secondary reference and modify the primary reference for the purpose of increasing the data capacity on the disk and time efficiency in determining the disk type.

With respect to the limitations of claims 29 and 35. The primary and the secondary reference disclose determining the disk type and whether the disk is a single layer or a multi layer.

With respect to the limitation of claims 30 and 36. The primary reference determines the disk layer (single/multi) and the read out data (reflectivity) also determines the disk type as cited in column 6 lines 1-9 as shown by element "CD ROM data" signal.

With respect to the limitations of claims 31 and 37. the primary reference and the secondary reference disclose the use of determining if the disk a ROM non-copy or a RAM copy permitted disk.

With respect to the limitations of claims 32, 33 38 and 39. The claims merely read on a focusing servo signal to read a multi layer disk as cited in the secondary reference figs 27 and 28 and thus obvious to one skilled in the art.

Claims 1-27 are allowed.

Applicant's arguments filed March 25, 2005 have been fully considered but they are not persuasive. Applicant's arguments are centered around the prior art not showing the limitation "determining a type of optical disk based on in-focus timing and count...said in-focus timing". Such limitation is not defined in the claimed invention. The

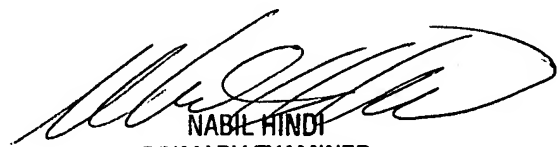
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limitation "count" is not references nor cited of what is based on. The limitation merely read on a focusing error signal or any other signal that is related to detecting a focusing status. The limitation in-focus and count is present within the S-curved focusing error signal as it is well established in the art in order to determine the disk type or the number of optical recording layers in the disk.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to **NABIL Z HINDI** at telephone number (703) 308-1555.


NABIL HINDI
PRIMARY EXAMINER
GROUP 2500
2435